

REMARKS

In the Office Action, the Examiner rejected claim 1 under 35 U.S.C. § 112, second paragraph; rejected claims 1-7, 9-13, 16-18, 20-26, 29-37, 39-43, and 46-53 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,771,761¹ to LaPierre et al. ("LaPierre"); rejected claims 8 and 38 under 35 U.S.C. § 103(a) as being unpatentable over LaPierre in view of U.S. Patent Application Publication No. 2002/0076031 of Falcon et al. ("Falcon"); and rejected claims 27 and 28 under 35 U.S.C. § 103(a) as being unpatentable over LaPierre in view of U.S. Patent No. 4,839,916 to Fields et al. ("Fields") and/or U.S. Patent No. 5,838,767 to Aoyama ("Aoyama").

By this Reply, Applicants had amended claims 1, 17, and 31. Claims 1-13, 16-18, 20-43, and 46-53 are currently pending, with claims 1, 17, and 31 being independent. Claims 14, 15, 19, 44, and 45 have been canceled in previous amendments, without prejudice or disclaimer. Based on the foregoing amendments and the following remarks, Applicants respectfully traverse the rejections of the pending claims.

I. The § 112, Second Paragraph, Rejection of Claim 1

The Examiner rejected claim 1 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

¹ Although pages 2, 7, and 8 of the Office Action refers to U.S. Patent No. 6,795,543, the Applicants' representative confirmed with the Examiner on June 11, 2007, that this was an error in the Office Action and that the correct patent number for the reference is 6,771,761, as listed under Notice of References Cited. Applicants respectfully request correction in any future communication.

which applicant regards as the invention allegedly because the term “customer” is indefinite, and it is unclear how the terms “devices” and “service centers” related. Office Action at 2. Applicants respectfully submit that the term “customer” is used throughout the specification, and one of ordinary skilled in the art would not find the term, as recited in claim 1, indefinite in view of the descriptions in the specification. With respect to the terms “devices” and “service centers,” although Applicants respectfully disagree with the Examiner, Applicants have amended claim 1 to remove the term “device,” in an effort to advance prosecution. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 112, second paragraph, rejection of claim 1.

II. The § 103(a) Rejection of Claims 1-7, 9-13, 16-18, 20-26, 29-37, 39-43, and 46-53 Under 35 U.S.C. § 103(a) Based on LaPierre

Applicants respectfully traverse the rejection of claims 1-7, 9-13, 16-18, 20-26, 29-37, 39-43, and 46-53 under 35 U.S.C. § 103(a) as being unpatentable over LaPierre. A *prima facie* case of obviousness has not been established with respect to claim 1-7, 9-13, 16-18, 20-26, 29-37, 39-43, and 46-53.

“The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “All words in a claim must be considered in judging the patentability of that

claim against the prior art.” M.P.E.P. § 2143.03. “In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Amended independent claim 1 recites “[a] method for routing a call dialed using one of a plurality of numbers, the plurality of numbers comprising a first number associated with a first service, and a second number associated with the first service and a second service.” The method includes, among other steps, “receiving a call dialed using one of the plurality of numbers from a calling party, wherein the call includes a trigger number,” “determining whether the trigger number is associated with the first or second number,” “based on the determination that the trigger number is associated with the second number, requesting the calling party to select the first or second service,” and “based on the determination that the trigger number is associated with the first number, requesting the calling party to select one of a plurality of related types of the first service.” LaPierre does not teach or suggest at least the combination recited in claim 1.

The Examiner asserted that LaPierre teaches “routing a call directed to devices associated with one of a plurality of numbers (Fig. 1, SCP 20 and SMS 10), the plurality of numbers comprising a first number associated with a first service, and second number associated with first service and second service (Abstract, lines 10-15),” and “receiving a call directed to devices associated with one of the plurality of numbers from a calling party, wherein the call includes a trigger number.” Office Action at 2. This is incorrect.

Instead, LaPierre is directed to a “system and method for caller-selectable call routing from a **single telephone number**.” See LaPierre, Title. (emphasis added). A “telephone [subscriber] often use[s] multiple telephone numbers for both personal and business purposes. With so many different telephone numbers, . . . people often have to call several different numbers before reaching their desired party.” LaPierre, col. 1, lines 14-21. To solve these problems, LaPierre provides a method for the subscriber to “combine access to multiple residential and business telephone numbers via a **single universal number**.” LaPierre, Abstract, lines 5-6. (emphasis added). Once the subscriber combines the multiple telephone numbers into a single universal number by signing up for the universal number service, a calling party may dial the single universal number and select one routing destination from alternate destinations associated with the subscriber. LaPierre, col. 2, lines 15. The Abstract, lines 10-15, of LaPierre, which, according to the Office Action, allegedly discloses a plurality of numbers, merely discloses multiple destinations that can be routed **from** the single universal number.

Thus, LaPierre, in fact, teaches away from “routing a call dialed using one of a plurality of numbers, the plurality of numbers comprising a first number associated with

a first service, and a second number associated with the first service and a second service,” and “receiving a call dialed using one of the plurality of numbers from a calling party, wherein the call includes a trigger number,” as recited in amended independent claim 1. Because the caller of LaPierre dials a single universal number, nowhere does LaPierre teach or suggest “a first number associated with a first service, and second number associated with the first service and a second service,” as recited in amended independent claim 1.

In addition, LaPierre does not teach or suggest “determining whether the trigger number is associated with the first or second number,” as recited in amended independent claim 1. As explained above, there is only one universal number in the system of LaPierre. Thus, LaPierre does not teach or suggest “determining whether the trigger number is associated with the **first or second number**,” as recited in amended independent claim 1 (emphasis added).

The Examiner asserted that “determin[ing] whether the subscriber (caller) associated with the dialed number has signed up for the universal number service” teaches or suggests “determining whether the trigger number is associated with the first or second number.” Office Action at 3. Applicants respectfully disagree with the assertion, and submit that determining whether someone has signed up for a service has nothing to do with, and/or requires different processes than, determining whether the trigger number is associated with the first or second number. This is true especially because the system of LaPierre determines whether someone has signed up for a service to play an error message in case someone has not. This is not the case for

"determining whether the trigger number is associated with the first or second number," as recited in amended independent claim 1.

Moreover, because LaPierre teaches "a single universal number" and thus fails to teach or suggest "determining whether the trigger number is associated with the first or second number," LaPierre also fails to teach or suggest "based on the determination that the trigger number is associated with the second number, requesting the calling party to select the first or second service," and "based on the determination that the trigger number is associated with the first number, requesting the calling party to select one of a plurality of related types of the first service," as recited in amended independent claim 1. The Examiner correctly observed that "LaPierre does not teach based on the determination that the trigger number is associated with the second number, requesting the calling party to select the first or second service." Office Action at 3.

The Examiner, however, in a clearly improper hindsight fashion, alleged that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to adding the teachings of LaPierre in steps 214-224 into step 212 of FIG. 2 in order to request the calling party to select a first or second service, in response to the determination that the trigger number does not match the predetermined trigger number." Office Action at 4. The hindsight reasons identified by the Examiner are, at best, conjecture and clearly show the insufficiencies of the LaPierre reference. Because LaPierre discloses routing from only a **single** universal number, the system can only either (1) provide a caller with a list of destinations to select from (step 214) or (2) play an error message (step 212), based on the determination whether a subscriber

associated with the single universal number has signed up for the universal number service or not. Adding steps 214-224 to step 212, which would allow the caller to select one of the subscriber's destinations even when the subscriber has not subscribed to the service would make no sense, and it would defeat the purpose of having the determining step of 210. “[R]equesting the calling party to select the first or second service” and alternatively “requesting the calling party to select one of a plurality of related types of the first service,” “based on determination that the trigger number is associated with the second number [or the first number,]” as recited in amended independent claim 1, are not plausible in the system of LaPierre, which routes from only a single universal number.

In view of the above-noted deficiencies of LaPierre reference, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 1. In addition, because LaPierre teaches away from routing a call dialed using one of a plurality, there is no motivation for one of ordinary skill in the art to modify the teachings of LaPierre to achieve the invention of claim 1. Thus, the Office Action has failed to clearly articulate a reason why claim 1 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 1 and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

Amended independent claims 17 and 31, although of different scope, recite features that are similar to the features recited in amended independent claim 1. For reasons at least similar to the reasons set forth above with respect to amended

independent claim 1, LaPierre fails to support the § 103(a) rejection of amended independent claims 17 and 31. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of amended independent claims 17 and 31 based on LaPierre.

Claims 2-7, 9-13, 16, 47, and 50-53 depend from claim 1; claims 18, 20-26, 29, 30, and 48 depend from claim 17; and claims 32-37, 39-43, and 46, 49 depend from claim 31. Thus, claims 2-7, 9-13, 16, 18, 20-26, 29, 30, 32-37, 39-43, and 46-53 are allowable at least by virtue of their dependence from an allowable independent claim. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103 rejection of claims 2-7, 9-13, 16, 18, 20-26, 29, 30, 32-37, 39-43, and 46-53 based on LaPierre.

III. The § 103(a) Rejection of Claims 8 and 38 Under 35 U.S.C. § 103(a) Based on LaPierre and Falcon

Claims 8 and 38 depend from amended independent claims 1 and 31, respectively. As explained above, LaPierre does not teach or suggest the combination of steps and elements recited in claims 1 and 31. Falcon does not cure these deficiencies, and the Office Action does not allege otherwise as Falcon is relied upon only for its alleged teachings of “a system for connecting a caller making a service request to any number of agents, remote or local, servicing a plurality of call centers, taking and storing caller information such as past caller history which would include any calls abandoned by a caller.” Office Action at 8. Moreover, Falcon is not prior art to the present application. Falcon was filed November 20, 2001, more than a year after the filing date of this application.

Therefore, the rejection based on LaPierre and Falcon must be withdrawn.

Moreover, LaPierre and Falcon, taken alone or in combination, fail to teach or suggest the recited elements of amended independent claim 31. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claims 8 and 38 based on LaPierre and Falcon.

IV. The § 103(a) Rejection of Claims 27 and 28 Under 35 U.S.C. § 103(a) Based on LaPierre, Fields, and Aoyama

Claims 27 and 28 depend from amended independent claim 17. As explained above, LaPierre does not teach or suggest the combination of steps and elements recited in claims 1 and 17, including, “receiving a call dialed using one of the plurality of numbers from a calling party, wherein the call includes a trigger number,” “determining whether the trigger number is associated with the first or second number,” “based on the determination that the trigger number is associated with the second number, requesting the calling party to select the first or second service,” and “based on the determination that the trigger number is associated with the first number, requesting the calling party to select one of a plurality of related types of the first service.” Fields and/or Aoyama fail to cure the deficiencies of LaPierre, and the Office Action does not allege otherwise as Fields and/or Aoyama are relied upon only for their alleged teachings of “systems [having] the ability to detect when a call or action is real or when it is merely a test.” Office Action at 8 and 9. Therefore, LaPierre, Fields, and Aoyama, taken alone or in combination, fail to teach or suggest the recited elements of claim 17. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claims 27 and 28 based on LaPierre, Fields, and Aoyama.

V. Conclusion

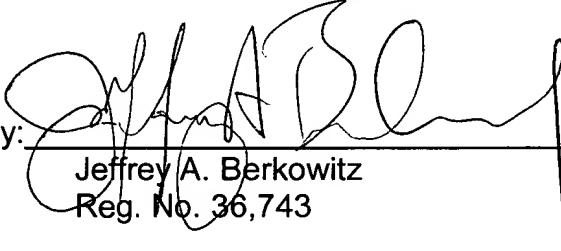
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims².

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 23, 2008

By: 
Jeffrey A. Berkowitz
Reg. No. 36,743

² As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, ability to combine references, assertions as to patentability of dependent claims) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.